

REMARKS

The Office Action mailed December 19, 2003 has been carefully considered.

Claim 1 has been amended to more clearly define applicants' invention.

Applicants acknowledge with much appreciation the indication that claims 13 and 14 would be allowable if rewritten in independent form.

The examiner has rejected claims 1-11 under 35 U.S.C. § 103(a) as "being unpatentable over Larson in view of Sulzback et al. as set forth in the previous Office Action, and further in view of European Patent 0 510 407" (European Patent). It is the examiner's view that the European Patent discloses the aspect of moving on applicator in a direction corresponding to longitudinal movement and that it would be obvious to incorporate this aspect into the method of Larson in order to prevent the application of foam ingredients in an undesired location.

For reasons set forth below, applicants respectfully traverse the rejection of claims 1-11.

The present invention is specifically directed to introduce a two-dimensional movement of the application orifice in order to distribute the foam material within the cassette (the two-dimensional movement appears as the foam is applied into the cassette).

The examiner's attention is invited to applicants' discussion of the Larson and Sulzback references as set forth in the Remarks that accompanied the Amendment mailed October 1, 2003.

The European patent refers to a one-dimensional longitudinal movement of the orifice in order to let the jet of application be interrupted due to the first movement in order to avoid a wetting of the transverse bar 3.

The Examiner has argued that a combination of Larson and Sulzbach would be motivated by the fact that one of the useful functions of the mix heads of Sulzbach, with the capability of reciprocating movement, is to cover the width of the conveyor belt. However, one skilled in the art would see no necessity for this combination, since Larson proposes a plurality of dispensing nozzles (col. 4, l. 10, Fig. 2), in order to cover the necessary width, so that any further moving mechanism would seem an

unnecessary complication. Further, Sulzbach uses a one-dimensional transverse movement of the application orifice in order to distribute the foam between a lower and an upper skin layer, not within a cassette. One skilled in the art would expect difficulties in transferring this movement to Larson in that the frame parts at the transverse sides might be contaminated by foam applied in a moving manner and thus would prefer the multiple nozzle solution according to Larson being stationary. In any case, the combination of Larson and Sulzbach would only lead to a one-dimensional movement of the application orifice in an apparatus according to Larson.

The examiner has cited the European Patent as also referring to foam application. Column 3, line 52 mentions a broad slit orifice adapted to wetten the complete width of the cassette ("Breitschlitzdüse, die für eine Benetzung über die gesamte Breite der Kassette sorgt"). Fig. 3 shows movements of this orifice in the moving direction of the cassette that shall be performed so fast that the exciting foam jet is interrupted in order to avoid a wetting of transverse bar 3 (column 4, lines 1-4 and 12-14: "...und zwar so schnell, dass der austretende Schaumstrahl abreißt und so im wesentlichen eine Benetzung des Querbalkens 3 vermieden wird...erfolgt so schnell, dass der austretende Gemischstrang abreißt"). The same applies to Fig. 4. This is said to be an alternative to closing the jet line according to Fig. 5. I.e.: The European Patent proposes a longitudinal movement in order to avoid a foam distribution following this longitudinal movement and not in order to let the foam application be distributed in an optimized manner within the cassette.

Thus, one skilled in the art combining this with Larson will see that a (transversely) stationary orifice is in both cases adequate for a distribution of the foam over the necessary width. Thus, such a combination would lead – if at all – to a one-dimensional longitudinal movement of the orifice in the apparatus according to Larson. Sulzbach, on the other hand, does not show any transverse bars (reference numerals 13 and 14 in Fig. 2 being rolls) but refers to continuous skin layers. Thus, starting from Sulzbach, the skilled person sees no reason to consider the teaching of the European Patent.

The Examiner has deemed that a combination of all three references would render the invention obvious. It cannot be seen why a combination of these references, in which two refer to cassettes and both show transversely stationary orifices, teaches to introduce transversely reciprocating orifices for applying foam into cassettes. It further seems that it is not obvious at all to combine just these three references. Namely, it seems to be a hindsight analysis to start from Larson, take the transverse movement from Sulzbach and the longitudinal movement from the European Patent, thereby already knowing the invention and seeking for the feature combination of the invention. The prior art clearly shows that in foam application, two-dimensional movements of orifices have not been considered. The orifices have been stationary (Larson) or movable in one direction (Sulzbach and European Patent). Therein, the longitudinal movement has not been associated with the foam distribution within the cassette and thus, from the basic approach, is completely different compared to the present invention.

The examiner's combination of the above-discussed references is not well taken. The factual inquiry whether to combine references must be thorough and searching.

Attention is invited to *Winner International Royalty Corp. V. Wang*, 202 F. 3d 1340, 1348 (Fed. Cir. 2000) where the court stated that "When an obviousness determination is based on multiple prior art references, there must be a showing of some "teaching, suggestion, or reason" to combine the references. *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573, 1579, 42 U.S.P.Q. 2d 1378, 1383 (Fed. Cir. 1997) (also noting that the "absence of such a suggestion to combine is dispositive in an obviousness determination")."

Further, the court in *Winner* stated, at 202 F. 3d 1348-49, "...the showing of combinability, in whatever form, must nevertheless be 'clear and particular'."

Also, attention is directed to the court's guidance set forth in *In re Lee*, 277 F. 3d 1338, 1343, 61 U.S.P.Q. 2d 1430, 1433 (Fed. Cir. 2002):

"When patentability turns on the question of obviousness, the search for and analysis of the question of the prior art includes evidence relevant to the finding of whether there is a teaching motivation, or

suggestion to select and combine the references relied on as evidence of obviousness.”

In the instant situation, the prior art teaches away from providing a two-dimensional movement of the application orifice in order to distribute foam material within the cassette. Without any such teaching, suggestion, or acknowledgment of such a possibility, there would not have been an incentive for one of ordinary skill in the art to combine the cited references.

It would only be hindsight that would allow the Examiner to present any argument at all in rejecting claims 1-11 of the instant application. As stated in *In re Dembiczak*, 175 F.3s 994, 999, 50 U.S.P.Q. 2d 1614, 1617 (Fed. Cir. 1998):

“Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for showing of the teaching or motivation to combine prior art references...Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor’s disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.”

With regard to claim 4, it is first to be seen that a two-dimensional movement is not obvious from the prior art, as argued above. Further, a graphic line programming of such movement relative to the cassette is still more distant from the prior art in that the longitudinal movement according to the European Patent is not connected to foam distribution patterns within the cassette. Finally, the European Patent teaches the longitudinal movement as an alternative to closing phases, whereas claim 4 teaches to introduce both (compare Fig. 3 and the travel parts crossing areas 37).

With regard to claim 5, a second applicator combined with a first movable applicator is not mentioned in the prior art at all.

With regard to claim 9, neither an opening in the foam layer nor a two-dimensional movement in order to bypass this opening with the foam is shown in the prior art.

It is of interest to note that claims of similar scope to those presently being presented were recently allowed in corresponding EP 00 107 724.7-2420.

In view of the above, it is respectfully submitted that the application is now in condition for allowance.

Respectfully submitted,

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CERTIFICATE OF MAILING

I hereby certify that this Amendment and any other documents referred to as enclosed herein, are being deposited in an envelope with the United States Postal Service "Via US First Class Mail to Addressee" on 03-19-04 and addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.


